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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,789

09/19/2005

Winfried K. W. Holscher

05-636

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34704 7590 06/06/2008

BACHMAN & LAPOINTE, P.C.

900 CHAPEL STREET

SUITE 1201

NEW HAVEN, CT 06510

EXAMINER

MACARTHUR, VICTOR L

ART UNIT

PAPER NUMBER

3679

MAIL DATE

DELIVERY MODE

06/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/549,789	Applicant(s) HOLSCHER, WINFRIED K. W.	
	Examiner VICTOR MACARTHUR	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-73 is/are pending in the application.
- 4a) Of the above claim(s) 48-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/19/05, 12/18/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Species 1, figures 2-6, claims 38-47, in the reply filed on 5/5/2008 is acknowledged.

Claims 48-73 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/5/2008.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Take for instance the following examples:

- The preamble recites "for connecting a first extruded hollow profile, having a profile channel and at least one undercut groove space on a longitudinal groove to another workpiece fixed to the hollow profile" as a mere functional intended use, such that it appears that the claimed "connecting device" (line 1 of claim 38) is not structurally limited by a "hollow profile", "profile channel", "undercut groove space",

"longitudinal groove", or "another workpiece". However, the above elements are referred to positively elsewhere in the claims such that it is unclear what if any of the above elements is meant to structurally limit the claimed invention and what elements are mere intended uses for the "Connecting device".

- The limitation "to **another** workpiece" (line 4 of claim 38) is unclear since no initial workpiece is expressly recited (emphasis added).
- The phrase "strip-like" appears in claim 38, line 5. The addition of the word "like" to an otherwise definite expression extends the scope of the expression so as to render it indefinite. It is unclear what the word "like" is intended to convey. See MPEP § 2173.05(b).
- The phrase "the rest position" (lines 8-9) lacks proper antecedent in such a manner as to render the claims unclear.
- The phrase "the side contours" (line 9) lacks proper antecedent in such a manner as to render the claims unclear.
- The phrase "the connecting position" (line 10) lacks proper antecedent in such a manner as to render the claims unclear.
- The phrase "the undercut space (24)" (lines 11-12) lacks proper antecedent in such a manner as to render the claims unclear. Note that this phrase does not appear to refer to the previously recited "at least one undercut groove space (22)" (lines 3-4) in that the recitations have separate reference characters.
- The phrase "the other hollow profile" (line 12) lacks proper antecedent in such a manner as to render the claims unclear.

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 follows based on the examiner's best understanding of the claim scope. The applicant is strongly urged to amend the entirety of the claims **(not only the examples listed above)** to conform to current U.S. practice.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 38-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoscher (U.S. Patent 6,582,149).

Holscher appears to disclose all of the applicants elected claim limitations as best understood by the examiner (see 35 U.S.C. § 112 2nd paragraph rejections above).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

June 6, 2008

/Victor MacArthur/
Primary Examiner, Art Unit 3679